

Decision for dispute CAC-UDRP-104562

Case number CAC-UDRP-104562

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Domain names bestisabelmarant.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization IM PRODUCTION

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name ZhaoDongmei Zhao

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the domain name <bestisabelmarant.com> (“the disputed domain name”).

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks:

- International trade mark registration no. 1284453, registered on 16 November 2015, for the word mark ISABEL MARANT, in classes 4, 8, 11, 16, 20, 27 and 28 of the Nice Classification; and
- EU trade mark registration no. 001035534, registered on 3 May 2000, for the word mark ISABEL MARANT, in classes 3, 14 and 25 of the Nice Classification.

(hereinafter, collectively or individually, “the Complainant’s trade mark”; “the Complainant’s trade mark ISABEL MARANT”; or “the trade mark ISABEL MARANT” interchangeably).

FACTUAL BACKGROUND

The Complainant’s contentions can be summarised as follows:

A. Background history

The Complainant is a French company which operates in the manufacture and marketing of ready-to-wear, shoes, handbags and jewellery. The Complainant commercialises its products worldwide.

In addition to the trade marks mentioned in the section "Identification of rights" above, and other trade marks in its portfolio, the Complainant informs that it is also the owner of multiple domain names which contain the term "ISABEL MARANT", including <isabelmarant.com>, which was registered in 2002.

By way of relief, the Complainant seeks the transfer of the disputed domain name <bestisabelmarant.com> to the Complainant on the grounds advanced in section B below.

B. Legal grounds

I. The disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights

The Complaint submits that the disputed domain name <bestisabelmarant.com> is confusingly similar to the Complainant's trade mark ISABEL MARANT; that the addition of the word "best" is insufficient to avoid the likelihood of confusion; and that it is well established that generic Top-Level Domains ("gTLDs"), in this case <.com>, are not relevant in the appreciation of confusing similarity.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not carry out any activity for, or has any business with, the Complainant. Neither licence nor authorisation has been given to the Respondent to make any use of the Complainant's trade mark ISABEL MARANT, or to apply for registration of the disputed domain name on the Complainant's behalf. Moreover, the Respondent is not known by the disputed domain name.

The Complainant avers that the disputed domain name was registered on 28 April 2022, and that it resolves to a website purporting to be an online store selling the Complainant's ISABEL MARANT products at reduced prices ("the Respondent's website"). The Complainant further avers that the Respondent's website demonstrates neither a bona fide offering of goods nor a legitimate interest of the Respondent. In addition, the Respondent failed at least in one of the elements of the Oki Data test, namely the Respondent's website does not disclose accurately and prominently the Respondent's relationship with the trade mark holder.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

The Complainant states that, given the distinctiveness of the Complainant's trade mark and reputation, it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trade mark ISABEL MARANT.

The Complainant further states that, in registering and using the disputed domain name, which incorporates the Complainant's trade mark with the additional word "best", the Respondent is seeking to create an impression that its website is the Complainant's official website. Moreover, the use of the Complainant's trade mark on the Respondent's website, without displaying a clear and accurate disclaimer of a lack of relationship between the Respondent and the Complainant, is indicative of bad faith.

The Complainant contends that the Respondent has therefore intentionally used the disputed domain name to attract, for

commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (paragraph 4(b)(iv) of the UDRP Policy).

The Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The UDRP threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and are being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities, which lays down the foundations for panels to determine each of the three Policy elements.

I. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trade mark rights in "ISABEL MARANT" since 2000.

The disputed domain name is <bestisabelmarant.com>, and the Complainant's trade mark is ISABEL MARANT.

The Panel has no difficulty in finding that the disputed domain name is confusingly similar to the Complainant's trade mark ISABEL MARANT, in accordance with paragraph 4(a)(i) of the UDRP Policy.

The adjacent word "best" in the disputed domain name string has no material impact on the confusing similarity assessment, such that the disputed domain name clearly evokes the Complainant's trade mark ISABEL MARANT.

Lastly, the gTLDs, in this case <.com>, are typically disregarded by UDRP panels under this Policy ground (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

II. Rights or Legitimate Interests

The Respondent has defaulted in these UDRP proceedings. Nevertheless, the Panel is empowered to draw adverse inferences from the Respondent's silence (UDRP Rule 14 (b)).

The Panel notes that the Complainant firmly denies any affiliation and/or association with, or authorisation/endorsement/sponsorship for, the Respondent of any nature. Moreover, the Complainant argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Panel also notes that the Complainant claims not to have authorised the Respondent to commercialise the Complainant's products on the Respondent's website. On this particular point, the Panel refers to paragraph 2.8 of the WIPO Jurisprudential Overview 3.0, according to which resellers, distributors or service providers using a domain name containing a complainant's trade mark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services, and thus have a legitimate interest in such domain name. UDRP Panels have termed this as the "Oki Data test" (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), which comprises the following four cumulative requirements:

1. The respondent must actually be offering the goods or services at issue;
2. The respondent must use the site to sell only the trade marked goods or services;
3. The website must accurately and prominently disclose the registrant's relationship with a trade mark holder; and
4. The respondent must not try to "corner the market" in domain names that reflect the trademark.

The Respondent would fail to meet the Oki Data test, the Panel being unable to locate any disclaimer regarding the relationship between the Respondent and the Complainant (item 3. above). The Panel is furthermore unconvinced that, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent has submitted no evidence to refute any of the Complainant's assertions. Instead, there is robust evidence on the available record suggesting that the Respondent has attempted to impersonate the Complainant, as discussed under item III. below.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

III. Registered and Used in Bad Faith

Registration

The following elements are compelling evidence to this Panel that the disputed domain name was registered in bad faith:

- The Complainant has been in operation since at least 2000, whereas the disputed domain name <bestisabelmarant.com>, which incorporates the Complainant's trade mark ISABEL MARANT in its entirety, was registered in 2022;
- The Complainant operates its activities through various domain names which contain the term "ISABEL MARANT", in particular <isabelmarant.com>, which was registered in 2002;
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its field of business; and
- The Respondent's lack of participation in the course of these UDRP proceedings.

Use

The Complainant refers to the Respondent as being engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy, which provides as follows:

"(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location."

At the time of writing, the disputed domain name does not resolve to an active webpage. Nevertheless, the Panel has perused the available record and found compelling indicia to establish that the Respondent appeared to have commercialised ISABEL MARANT products through the Respondent's website, in an unauthorised manner, and absent any disclosure as to the relationship between the Respondent and the Complainant. The Panel considers that the Respondent has attempted to suggest an affiliation with, or a connection to, or an endorsement of the Complainants or, rather likely, to impersonate the Complainant through the use of the trade mark ISABEL MARANT on the Respondent's website. The Respondent's behaviour would consequently fall into the remit of circumstance (iv) of paragraph 4(b) of the UDRP Policy.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. BESTISABELMARANT.COM: Transferred

PANELLISTS

Name	Yana Zhou
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DATE OF PANEL DECISION	2022-06-03
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Publish the Decision
